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10/688,203	10/17/2003	Jarmo Kuusinen	NOKM.079PA	6660

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Crawford Maunu PLLC		JUNTIMA, NITTAYA	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/688,203	KUUSINEN ET AL.
	Examiner	Art Unit	
	Nittaya Juntima	2663	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _17 October 2003_.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-49_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-49_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _17 October 2003_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _4/26/04_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claims 29, 30, 32-38, and 40 are objected to because of the following informalities:

In claims 29, 30, 32-38, and 40, "is configured to" and "configured to" should be

changed to make the limitations positive. An alternative to the suggested change would be a

written confirmation stating that the claimed element performs the actual function following "is

configured to" and "configured to." It has been held that the recitation that an element "is

configured to" or being "configured to" perform a function is *not* a positive limitation but only

requires the ability to so perform. It does not constitute a limitation in any patentable sense.

· Appropriate correction is required.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-6, 18, 21-32, 39-42, and 45-46 are rejected under 35 U.S.C. 102(e) as being

anticipated by Bodin et al. ("Bodin") (USPAP US 2005/0025047 A1).

Regarding claim 1, Bodin teaches a method (Fig. 3) for providing services via a packet-switched (PS) multimedia network to users communicating in a circuit-switched (CS) domain, comprising:

Establishing a dialog (SIP signaling for a call session, paragraphs 0026-0027) between a plurality of terminals (MS 306 and MGW 318) through the PS multimedia network (IMS, paragraph 0024).

Providing at least one service (IP-based, real-time, conversational, multimedia services) to at least one of the terminals (MS 306) via the dialog. (paragraphs 0024 and 0027).

Communicating CS bearer information (indication that a circuit bearer is being used) between the plurality of terminals (MS 306 and MGW 318) via the dialog (SIP signaling), wherein the CS bearer information includes at least an indication that a communication flow (a circuit connection,) is requested via a CS network (including in one of the SDP packets in the SIP INVITE message body that a circuit bearer is being used, e.g. using a codec value, Fig. 4 and paragraphs 0025, 0027, and 0030-0031).

Effecting the communication flow between the plurality of terminals via the CS network as directed by the CS bearer information (paragraphs 0027, 0030-0031).

Regarding claims 2 and 28, Bodin teaches establishing the dialog (SIP signaling) between the plurality of terminals (MS 306 and MGW 318, Fig. 3) utilizing SIP via a SIP infrastructure (P-CSCF 314 and I/S-CSCF 316, paragraph 0025 and Fig. 4).

Regarding claims 3 and 27, Bodin teaches an IMS (paragraph 0024), and establishing a dialog using a SIP through the IMS (paragraphs 0024-0025 and Fig. 4).

Regarding claim 4, Bodin teaches wherein establishing a dialog using SIP comprises

sending a SIP INVITE message from a first (MS 306, Fig. 4) of the plurality of terminals to at

least a second (MGW, Fig. 4) of the plurality of terminals (paragraphs 0030), and wherein

communicating CS bearer information (indication that a circuit bearer is being used) comprises

communicating the CS bearer information by way of a session description (SDP packet)

provided via a message body of the SIP INVITE message (paragraphs 0030-31).

Regarding claims 5-6 and 18, Bodin teaches that communicating CS bearer information

(indication that a circuit bearer is being used) comprises communicating the CS bearer

information by way of a session description definition/a SDP (SDP packet) provided via the SIP

dialog (paragraph 0031).

Regarding claims 21 and 25, Bodin teaches that at least one service includes audio

service, video telephony service, and multimedia conference service through the CS network

(call session for providing IP-based, real-time, conversational, multimedia services is established

through a circuit connection, paragraphs 0024 and 0026-0027).

Regarding claim 22, Bodin teaches that effecting the communication flow between the

plurality of terminals via the CS network comprises communication real-time media through the

CS network (paragraphs 0024 and 0026-0027).

Regarding claims 23 and 24, Bodin further teaches communicating a

conversational/streaming quality of service class flow through the CS network (IP QoS for IP

based, real-time, conversational, multimedia services is implemented through circuit connection,

paragraphs 0024, 0026-0027, and 0032).

Claim 26 is a method for establishing a CS connection containing similar limitations as

method claim 1 and is rejected under the same reason set forth in the rejection of claim 1 with an

addition of establishing a connection (320, Fig. 3) via the CS network based at least in part on the CS bearer information provided via the dialog (paragraph 0027).

Claim 29 is a terminal claim corresponding to method claim 1, and is therefore rejected under the same reason set forth in the rejection of claim 1 with the addition of a processing system, a first user agent, and a second user agent which must be included in the terminal (e.g. MS 306 in Figs. 3 and 4) in order to perform the functions as recited in the claim.

Claim 30 is a terminal claim containing limitation corresponding to method claims 1 and 2, is therefore rejected under the same reason set forth in the rejection of claims 1 and 2.

Claim 31 is a terminal claim containing limitation corresponding to method claim 3, is therefore rejected under the same reason set forth in the rejection of claim 3 with an addition of a SIP user agent which must be included in the terminal (e.g. MS 306 in Figs. 3 and 4) in order to perform the functions as recited in the claim.

Claim 32 is a terminal claim containing limitation corresponding to method claim 3, is therefore rejected under the same reason set forth in the rejection of claim 6 with an addition of a session description user agent which must be included in the terminal (e.g. MS 306 in Figs. 3 and 4) in order to perform the functions as recited in the claim.

Regarding claim 39, Bodin teaches the terminal (e.g. MS 306 in Fig. 3, paragraphs 0024-0025) comprises a mobile station wirelessly coupled to the PS multimedia network and CS network via a RAN (202, Fig. 2, paragraph 0022).

Claim 40 is a system claim corresponding to method claim 1, and is therefore rejected under the same reason set forth in the rejection of claim 1 with the addition of a receiver terminal (MGW 318, Fig. 4) which must include a receiver terminal processing system, a receiver

terminal SIP user agent (MGW 318 sending back a SIP 200 OK to MS 306, Fig. 4), and a

receiver terminal CS communication user agent (MGW 318 provides circuit connection to MS

306 as requested by SIP INVITE, Figs. 3 and 4), and a sender terminal (MS 306, Fig. 4) which

must include a sender processing system, a sender terminal SIP user agent, and a sender terminal

CS communication user agent in order to perform the functions as recited in the claim.

Claim 41 is a computer-readable medium having instructions stored thereon which are

executable by a computer system claim corresponding to method claim 1, and is therefore

rejected under the same reason set forth in the rejection of claim 1.

Claims 42, 45, and 46 are computer-readable medium claims corresponding to method

claims 3, 5, and 7, respectively, and are therefore rejected under the same reason set forth in the

rejection of claims 3, 5, and 7, respectively.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 7-15, 33-36, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Bodin et al. ("Bodin") (USPAP US 2005/0025047 A1) in view of *"SDP: Session*

Description Protocol" by Handley et al. ("Handley").

Regarding claims 7, 9, and 12, although Bodin teaches communicating the CS bearer

information by way of an SDP (SDP with a codec value indicating that a circuit bearer is being

used, paragraph 0031), Bodin fails to explicitly teach communicating at least some of the CS

bearer information via a media type particular to communication flows via the CS network.

However, Handely teaches a media type/a sub-field of a media type/a sub-field of an

application media type in an SDP which may be extended as new communication modalities

emerge (page 19).

Given the teaching of Handley, it would have been obvious to one skilled in the art at the

time the invention was made to modify the teaching of Bodin to include communicating at least

some of the CS bearer information via a media type/a sub-field of a media type/a sub-field of an

application media type particular to communication flows via the CS network such that the

media type would be extended to cover new communication, e.g. circuit bearer connection, as

taught by Handley (page 19), since such modification of an SDP packet only involves routine

skill in the art.

Regarding claims 8, 10, and 13, although Bodin teaches defining an SDP with a codec

value indicating that a circuit bearer is being used (paragraph 0031), Bodin fails to explicitly

teach communicating at least some of the CS bearer information via an SDP connection data

field identifying the CS network.

However, Handley teaches an SDP connection data field (page 12) with one additional

"c=" field per media description (page 12).

Given the teaching of Handley, it would have been obvious to one skilled in the art at the

time the invention was made to modify the teaching of Bodin to include communicating at least

some of the CS bearer information via an SDP connection data field identifying the CS network

since such modification of an SDP packet only involves routine skill in the art.

Regarding claims 11, 14, and 15, although Bodin teaches defining an SDP with a codec value indicating that a circuit bearer is being used (paragraph 0031), Bodin fails to teach communicating at least some of the CS bearer information via an SDP attribute/a session-level attribute indicative of a type of the communication flow to be effected via the CS network.

Handley, however, teaches an SDP attribute which additional fields may be added to convey additional information that is specific to an application, a media, or a session (pages 8 and 19)

Given the teaching of Handley, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Bodin to include communicating at least some of the CS bearer information via an SDP attribute/a session-level attribute indicative of a type of the communication flow to be effected via the CS network in order to convey additional information that is specific to a session, e.g. usage of circuit connection, as taught by Hanley (page 8), since such modification of an SDP packet only involves routine skill in the art.

Claims 33-36 are terminal claims containing limitation corresponding to methods claims 7, 9, 12, and 15, respectively, and are therefore rejected under the same reason set forth in the rejection of claims 7, 9, 12, and 15, respectively.

Claims 47-49 are computer-readable medium claims containing limitation corresponding to methods claims 9, 12, and 15, respectively, and are therefore rejected under the same reason set forth in the rejection of claims 9, 12, and 15, respectively.

6.   Claims 16-17, 19-20, 37-38, and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodin et al. ("Bodin") (USPAP US 2005/0025047 A1) in view of Kotzin et al. ("Kotzin") (USPAP US 2004/0120505 A1).

Regarding claims 16-17 and 19-20, although Bodin teaches defining an SDP in a SIP

body with a codec value indicating that a circuit bearer is being used (paragraph 0031), Bodin

fails to teach communicating at least some of the CS bearer information by way of a CS-specific

content type value associated with a SIP Content-Type header/a CS-specific value associated

with a CS-specific SIP header.

However, in an analogous environment specific to voice alert, Kotzin teaches a SIP

header (Fig. 5) having a Content-Type header (511) and ASCII characters (517) that are specific

to voice alert (paragraph 0031).

Given the teaching of Kotzin, it would have been obvious to one skilled in the art at the

time the invention was made to modify the teaching of Bodin to include communicating at least

some of the CS bearer information by way of a CS-specific content type value associated with a

SIP Content-Type header/a CS-specific value associated with a CS-specific SIP header as such

modification of a SIP header simply involves routine skill in the art.

Claims 37-38 are terminal claims containing limitation corresponding to methods claims

16 and 17, respectively, and are therefore rejected under the same reason set forth in the rejection

of claims 16 and 17, respectively.

Claims 43-44 are computer-readable medium claims corresponding to method claims 16

and 17, respectively, and are therefore rejected under the same reason set forth in the rejection of

claims 16 and 17, respectively.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

   - Bergenlid et al. (US 2003/0156578 A1), disclosing a packet-based conversational service for a multimedia session in a mobile communications system.

   - Ejzak (US 2003/0026245 A1), disclosing a communication system including an interworking mobile switching that translates the CS domain registration, call control, feature control and feature invocation procedures to standard SIP procedures.

   - Shaheen et al. (US 2003/0035401 A1), disclosing utilizing SIP for identifying user equipment resource reservation setup protocol capabilities.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nittaya Juntima
February 9, 2005
   NJ

RICKY NGO
PRIMARY EXAMINER